Ex parte Taylor et al.

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RUSSELL H. TAYLOR and YONG-YIL KIM

Appeal No. 96-1144
Application 08/223,969[1]

ON BRIEF

Before MEISTER, FRANKFORT and STAAB, *Administrative Patent Judges*.

MEISTER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 17-19, 21, 22 and 74-76. Claim 20, the only other claim remaining in the application, stands withdrawn from further consideration by the examiner under the provisions of 37 C.F.R. § 1.142(b) as being directed to a nonelected invention.

[1] Application for patent filed April 6, 1994. According to appellants, the application is a division of Application of 08/147,008, filed November 2, 1993, which is a continuation of Application 07/714,816, filed June 13, 1991.

The appellants' invention pertains to a system for manipulating movement of a surgical instrument. Independent claim 17 is further illustrative of the appealed subject matter and reads as follows:

17. A system for manipulating movement of a surgical instrument, the system comprising:

an apparatus having a plurality of motion joints, the apparatus being adapted for manual only driven motion and adapted to have the surgical instrument connected thereto;

a computer controlled brake located at least one of the motion joints of the apparatus;

a computer connected to the brake for selectively actuating the brake upon an occurrence of a predetermined event; and

means for signaling the computer of the occurrence of the predetermined event.

The reference relied on by the examiner is:

Glassman et al. (Glassman)	5,299,288	Mar. 29, 1994 (parent filed May 11, 1990)

Claims 17-19, 21, 22 and 74-76 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.[2] The examiner is

[2] The answer on page 2 states that "[t]his rejection is set forth in the prior Office action paper number 12 . . .," i.e., the final rejection. The final rejection, however, similarly states that claims 17-19 and 21 are rejected "for the reasons set forth on page 2 of the Office action dated 18 July 1994, " i.e. Paper No. 7. Such a procedure by the examiner is totally improper and inappropriate. M.P.E.P. 1208 expressly provides that incorporation by reference may be made only to a **single**

of the opinion that the various "adapted to" or "adapted for" clauses in the claims are "totally without structure to produce the results set forth therein" (see answer, page 3). With respect to claim 21 the examiner is of the opinion that this claim is further indefinite because

> the plurality of sensors are not connected to anything requiring a sensed sinal [sic, signal] nor is any indication given of what they sense, the claim is indefinite and incomplete. [See answer, page 3.]

Claims 17-19, 21, 22 and 74-76 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Glassman.

Having carefully considered the appellants' invention as described in specification, the claims on appeal, and the respective positions advanced by the appellants in the brief and by the examiner in the answer, it is our conclusion that neither of the above-noted rejections is sustainable.

Considering first the rejection of claims 17-19, 21, 22 and 74-76 under 35 U.S.C. § 112 second paragraph, the legal standard for indefiniteness is whether a claim reasonably apprises those of skill in the art of its scope. ***In re Warmerdam***, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). Here, the examiner has not even alleged that one of

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other action.

1994). Here, the examiner has not even alleged that one of ordinary skill in this art would not be reasonably apprised of the scope of these claims. Instead, the examiner's position is bottomed on the notion that insufficient structure has been recited to produce the results set forth in the various "adapted to" or "adapted for" clauses which set forth the function that the claimed structure is capable of performing. However, as the court in *In re Swinehart*, 439 F.2d 210, 213, 169 USPQ 226, 229 (CCPA 1971) stated:

> there is no support, either in the actual holdings of our prior cases or in the statute, for the proposition, put forward here, that "functional" language, in and of itself, renders a claim improper [under 35 U.S.C. § 112, second paragraph].

See also *In re Hallman*, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981): "It is well settled that there is nothing intrinsically wrong in defining something by what it does rather than what it is."

With respect to claim 19 the examiner states that the appellants "have not stated what the beacon represents" and with respect to claim 21 further states that "the plurality of sensors are not connected to anything requiring a sensed sinal [sic, signal] nor is any indication given of what they sense." These criticisms, however, go to the **breadth** of the claims in question, rather than the question of whether the artisan would be

reasonably apprised of the scope of these claims. It is well settled that just because a claim is broad does not mean that it is indefinite. *See In re Miller*, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971) and ***Ex parte Scherberisch***, 201 USPQ 397, 398 (Bd. App. 1977).

In view of the foregoing we will not sustain the examiner's rejection of claims 17-19, 21, 22 and 74-76 under the second paragraph of § 112.

Turning to the rejection of claims 17-19, 21, 22 and 74-76 under 35 U.S.C. § 102(e) as being anticipated by Glassman, the examiner is of the opinion that the motors of Glassman, when not energized, act as brakes. The examiner also objects to the reference in the summary of the invention in the brief which states that the appellants' apparatus is adapted for manual-only driven motion because "page 16, lines 15-21, [of the specification] for example, clearly indicate that computer control is also contemplated" (see answer, page 1). Thereafter, in the paragraph bridging pages 3 and 4, the answer states

> With respect to the rejection of the claims over [the] prior art, appellants wrongly argue on page 6 of their brief that the claimed device is for manual-only operation and therefore distinguishes from the motorized joints of the Glassman et al patent. There is no express limitation that manual-only operation [is required] and none is intended, especially in view of the

> portions of the specification noted above in the objection to appellant's summary of the invention. Reading the claims in light of the disclosure clearly flies in the face of distinguishing the claimed device from that of the prior art on the basis of manual- only [sic, manual-only] operation.

We agree with the examiner that the motors of Glassman act has brakes when they are not energized inasmuch as Glassman throughout his specification indicates that motion is "frozen" when the "manipulator power" is cut off (see, e.g., column 7, line 24 through column 8, line 4). We cannot agree, however, with the examiner's contention that there is no express limitation claimed which requires "manual-only" operation or that reading the claims in light of the disclosure "flies in the face" of distinguishing the claimed device over Glassman on the basis of this limitation.

Independent claim 17 expressly requires that the apparatus be "adapted for manual only driven motion" while independent claim 74 sets forth that the apparatus has a motion joint "adapted to be only manually moved by a user." These limitations set forth a function which the apparatus must be structurally capable of performing (**see, e.g., *In re Venezia***, 530 F.2d 956, 959, 189 USPQ 149, 151-52 (CCPA 1976)) and such a functional statement must be given full weight and may not be

disregarded in evaluating the patentability of the claims (**see, e.g., Ex parte Bylund**, 217 USPQ 492, 498 (Bd. App. 1981)). The appellants in the specification clearly describe the apparatus 10 shown in Fig. 1A to be a "manually passive movement apparatus" (see, e.g., page 15, line 33). When read in light of the specification, one of ordinary skill in this art would understand that the above-noted limitations require that the apparatus be capable of having whatever motive force is imparted thereto be imparted only manually by a user. Although the examiner is correct in noting that the specification on page 16 states that micrometer adjustment may be "either manually or computer controlled," we must point out that these are **alternative embodiments**, only one of which is being claimed (i.e., the embodiment of manual control).

As the examiner apparently recognizes, the apparatus of Glassman motor is moved by motors J1-J4 and PM which, as we have noted above, "freeze" when not energized. Accordingly, the apparatus of Glassman is not capable of performing the required "manual-only" operation. Even during the alignment and calibration procedure of Glassman wherein the surgeon grasps the distal end of the robot to position it by "force compliance," the force imparted by the surgeon is detected by force sensor 20

which in turn signals the controller 24 to move the robot (see column 9, lines 31-45). This being the case, we will not sustain the examiner's rejection of claims 17-19, 21, 22 and 74-76 under 35 U.S.C. § 102(e) as being anticipated by Glassman.

The examiner's rejections of the appealed claims under 35 U.S.C. § 112, second paragraph, and 35 U.S.C. § 102(e) are reversed.

REVERSED

JAMES M. MEISTER)
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)
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